

REMARKS

Claims 16-28 remain pending in the application (Claims 1-15 having been previously cancelled), with Claims 16, 20 and 24 being independent.

Claims 16, 20, 24 and 27 have been amended to change the objected to term "generally" to the recognized and accepted term "substantially". Claims 16, 20 and 24 have also been amended to include that the heat conductive composition comprises 60 to 90% by weight of paraffin and 10 to 40% by weight of graphite.

Claims 16-28 stand rejected under 35 U.S.C. § 112, second paragraph, the judicially created doctrine of obviousness type double patenting and under 35 U.S.C. § 102(e).

Applicants respond to these rejections in turn below.

Section 112 Rejection

Claims 16-28 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for the reasons given at pages 2-3 of the Action.

That is, Claims 16, 20, 24 and 27 are allegedly unclear due to the phrase "generally planar substrate", and Claims 17-19, 21-23, 25, 26 and 28 stand rejected due to their dependency on the above rejected claims.

Curiously, Freuler, the sole document cited by the Examiner against the pending claims, defines the invention described therein in terms of a "generally planar substrate", the very phrase that is objected to and rejected in the instant Office Action.

Since a U.S. patent is presumed to be valid, the claims thereof are presumed to satisfy all statutory requirements, including those set forth in Section 112.

Applicants submit therefore that the Patent and Trademark Office should stand by its earlier decision to grant a Letters Patent that defines an invention in a certain way.

Nevertheless, Applicants have amended the claims as noted to advance prosecution on the merits.

Reconsideration and withdrawal of the Section 112 rejections are therefore respectfully requested.

Double Patenting Rejection

Claims 16-28 stand rejected under the judicially created doctrine of obviousness type double patenting over Claims 1, 7-8 and 12 of U.S. Patent No. 6,616,999 for the reasons set forth at pages 2-4 of the Action.

Applicants are prepared to prepare and submit herewith a Terminal Disclaimer to disclaim the terminal portion of any

patent issuing upon this application, upon the written indication of allowable claims that define the invention and the written indication that the obviousness type double patenting rejection will be withdrawn upon submission and entry thereof.

Section 102(e) Rejection

Claims 16-18 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 5,912,805 (Freuler) for the reasons given at page 4-5 of the Action.

Applicants traverse the Section 102(e) rejection.

As the Examiner is aware, the present invention is directed to and claims a thermal interface positionable at a juncture between an electronic component and a heat sink for facilitating heat transfer from the electronic component to the heat sink. The thermal interface includes

a) a substantially planar substrate consisting essentially of a single layer having first and second surfaces and defining a first continuous peripheral edge, the peripheral edge having a portion thereof extending beyond the juncture between the electronic component and the heat sink;

b) a first layer of a heat conductive composition formed substantially about the first surface of the substrate, and a second layer of a heat conductive composition formed substantially about the second surface of the substrate, the

first and second layers further being formed upon the portion of the substrate extending beyond the juncture between the electronic component and the heat sink; and

c) a layer of adhesive formed upon a portion of a respective one of the layers of heat conductive material, the adhesive layer being localized upon the portion of the peripheral edge defined by the substantially planar substrate extending beyond the juncture between the electronic component and the heat sink. Significantly, the heat conductive composition comprises 60 to 90% by weight of paraffin and 10 to 40% by weight of graphite.

Freuler, on the other hand, is directed to and claims a thermal interface for facilitating heat transfer from an electronic component to a heat sink. The thermal interface of Freuler is defined by a) a first generally planar substrate having first and second surfaces and defining a first continuous peripheral edge; b) a second generally planar substrate having first and second surfaces and defining a second continuous peripheral edge, the first surface of the second substrate being compressively bonded to the second surface of the first substrate such that at least a portion of the second peripheral edge extends beyond the first peripheral edge; c) a layer of adhesive formed upon the portion of the second peripheral edge extending beyond the first peripheral edge; d) a first layer of

conformable, heat-conducting material formed upon the first surface of the first substrate, the heat-conducting material being formulated to enhance the heat transfer from the electronic component to the heat sink; and e) a second layer of conformable, heat-conducting material formed upon the second surface of the second substrate, the heat-conducting material being formulated to enhance the heat transfer from the electronic component to the heat sink.

It is well settled that in order to be an effective anticipatory reference, a single document must disclose each and every recitation of a claim under review in the same manner in which it is claimed. Failing such precise disclosure, rejections under Section 102 are improper. Here, the cited document does not possesses such disclosure.

That is, while each of the present invention and Freuler are directed to thermal interfaces, the present invention includes a heat conductive composition comprising 60 to 90% by weight of paraffin and 10 to 40% by weight of graphite, whereas Freuler does not.

Therefore, as Freuler does not disclose each and every recitation of the claims under review, the Section 102 rejections based thereon cannot stand and as such Applicants request reconsideration and withdrawal thereof.

In view of the above, favorable reconsideration and passage to issue of the present case are respectfully requested.

Applicants' undersigned attorney may be reached by telephone at (860) 571-5001, by facsimile at (860) 571-5028 or by e-mail at steve.bauman@us.henkel.com. All correspondence should be directed to the address given below.

Respectfully submitted,



Steven C. Bauman
Attorney for Applicants
Registration No. 33,832

Henkel Corporation
Legal Department
1001 Trout Brook Crossing
Rocky Hill, CT 06067